REMARKS

Claims 1-34 are pending in the present application. In the Office Action, the Examiner rejected claims 1-4, 6-8, 17-20, 20-24, and 33 under 35 U.S.C. 102(e) as being anticipated by Davis et al. (U.S. Patent Application No. 6,469,518). The Examiner's rejections are respectfully traversed.

Davis describes changing a measurement frequency based on a usage characteristic of a processing tool. For example, an automatic process controller may adjust a measurement frequency of a measurement tool based on usage characteristics of the processing tool. Exemplary usage characteristics include a time elapsed since a preventative maintenance task has been performed and a time elapsed since the particular part in the processing tool has been replaced. See Davis, col. 3, ll. 34-44.

In contrast, Applicants describe and claim determining a sampling plan for a metrology tool based on observed tool state variable values. Exemplary tool state variable values for an etch tool may include pressure, temperature, plasma power, and reactant gas flow rates. See Patent Application, page 8, ll. 20-21. Davis does not disclose at least these limitations in the pending claims. Thus, Applicants respectfully submit that the present invention is not anticipated by Davis and request that the Examiner's rejections of claims 1-4, 6-8, 17-20, 22-24, and 33 under 35 U.S.C. 102(e) be withdrawn.

Moreover, Davis is not prior art to the present application in the context of an obviousness analysis under 35 U.S.C. 103(a). According to MPEP §706.02(l)(1), "effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person

or subject to an obligation of assignment to the same person.' " The present application was filed on or after November 29, 1999. Furthermore, the present application and Davis were, at the time the present invention was made, owned by the same entity or subject to an obligation of assignment to the same entity. Thus, Applicants respectfully submit that Davis is not available as prior art in any obviousness determination.

In the Office Action, claims 1-4, 6-12, 14-20, 22-28, and 30-34 were rejected under 35 U.S.C. 102(e) as being anticipated by Shanmugasundram, et al (U.S. Patent Publication 2002/0193899). Claims 5, 13, 21, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shanmugasundram in view of Tobin, et al (U.S. Patent No. 5,982,920). The Examiner's rejections are respectfully traversed.

Shanmugasundram was filed on May 1, 2002 and claims priority to the provisional application 60/322,459, which was filed on September 17, 2001, and the provisional application 60/290,878, which was filed on June 19, 2001. Submitted herewith are declarations under 37 C.F.R. § 1.131 of the one of the named inventors, Christopher Bode, and of the undersigned agent that recite facts that establish that the Shanmugasundram patent is not prior art to the present application. More particularly, the declarations establish that, prior to June 19, 2001, the earliest effective filing date of the Shanmugasundram patent, the invention disclosed in the pending application was conceived and that all parties involved in preparing and filing the patent application with the United States Patent and Trademark Office were diligent. Accordingly, the Shanmugasundram patent is not prior art to the present application. Applicants respectfully request that the Examiner's rejections of claims 1-34 as being anticipated by, or obvious over, Shanmugasundram be withdrawn.

In the Office Action, claims 1-34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-37 of U.S. Patent No. 6,650,955. In the interest of expediency, Applicants have included herein a terminal disclaimer and respectfully request that the Examiner's rejection of claim 1-34 be withdrawn. However, it will be appreciated that the filing of the terminal disclaimer to obviate the Examiner's rejection is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. vs. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed Cir. 1991). See, *e.g.*, MPEP §804.03.

In the Office Action, claims 2, 10, 18, and 26 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner objected to the term "predetermined" as being vague and indefinite. Applicants respectfully disagree. The term "predetermined" as used in the phrase "predetermined threshold" means that the threshold is determined at some time prior to the time at which the action(s) set forth in these claims takes place. Applicants respectfully submit that persons of ordinary skill in the art would readily understand this from reading the specification. Thus, the term "predetermined" is clear and definite. Applicant respectfully requests that the Examiner's rejections of claims 2, 10, 18, and 26 be withdrawn.

The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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